

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)
060091.00447

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on _____

Signature _____

Typed or printed
Name _____

Application Number:

10/563,953

Filed: January 10, 2006

First Named Inventor:

Hasse SINIVAARA et al.

Art Unit: 2617

Examiner: Huy Q. PHAN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.
Registration No. 64,236

☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34 _____



Signature

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Telephone number

July 9, 2009

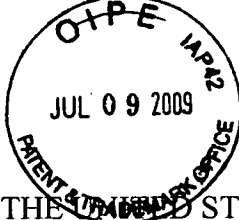
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 3591

Hasse SINIVAARA et al.

Art Unit: 2617

Application No.: 10/563,953

Examiner: Huy Q. PHAN

Filed: January 10, 2006

Attorney Dkt. No.: 060091.00447

For: BEACON TRANSMISSION IN SHORT-RANGE WIRELESS COMMUNICATION SYSTEMS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 9, 2009

Sir:

Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-2, 6-8, 10-11, 13-14, 22-24, and 35-36 in the above identified application. Claims 1-2, 6-8, 10-11, 13-14, 22-24, and 35-36 were finally rejected in the Office Action dated April 20, 2009. Applicants hereby respectfully submit that each of the remaining rejections contains clear error. A Notice of Appeal is timely filed concurrently herewith. Claims 1-37 are currently pending in the application, of which claims 1, 15, 22, 25, 31, and 35-37 are independent claims.

Clear Error 1: Claims 35-36 Comply with Written Description Requirement

Claims 35-36 were rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully submit that this rejection contains clear error because claims 35-36 comply with the written description requirement.

The Office Action asserted that the limitation "A computer-readable storage medium encoded with instructions configured to control a processor to perform a process" is not supported in the specification. Applicants respectfully submit that this rejection is improper because it appears to rigidly analyze the disclosure in view of the precise words "A computer-readable storage medium encoded with instructions configured to control a processor to perform

a process.” Instead, the appropriate analysis is whether the specification discloses the concept behind the words. The Federal Circuit has held, “To fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed” (*see Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364 (Fed. Cir. 2003)). However, the Federal Circuit has explained, “The disclosure as originally filed does not ... have to provide *in haec verba* support for the claimed subject matter at issue” (*see id.*). In other words, there is no requirement that the precise language used in the claims appear in the specification, in order to satisfy the written description requirement.

Here, the concept claimed is fully supported in the specification, in such a way that one of ordinary skill in the art would clearly conclude that the inventor invented what is claimed. Thus, the claims fully comply with the written description requirement. Specifically, the concept of a “A computer-readable storage medium encoded with instructions configured to control a processor to perform a process” is described in the specification, for example, at paragraph 34, which discloses that the terminals of the claimed invention can be made up of a portable computer with software. One of ordinary skill in the art would recognize that the portable computer with software corresponds to “A computer-readable storage medium encoded with instructions configured to control a processor to perform a process.” Furthermore, support for “A computer-readable storage medium encoded with instructions configured to control a processor to perform a process” may be found in the specification, for example, at paragraph 53, which discloses that a mobile terminal includes a control unit that performs the basic functions of the invention, and memory means that includes the control information needed for the functions. One of ordinary skill in the art would recognize that the memory means, the control information, the control unit, and the functions corresponds to a “computer-readable storage medium,” “instructions,” a “processor,” and a “process,” respectively. Therefore, the specification in the present application provides full and adequate support for the claim recitations. Accordingly, the rejection of claims 35-36 is clearly erroneous.

Clear Error 2: Claims 35-36 Are Directed to Statutory Subject Matter

Claims 35-36 were rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully submit that this rejection contains clear error because claims 35-36 are directed to statutory subject matter.

The Office Action asserted that the terminology “A computer-readable storage medium encoded with instructions configured to control a processor to perform a process” is not provided antecedent basis in the specification, and the limitation “computer-readable storage medium” is not disclosed in the specification to exclude signal medium. However, as discussed above, the specification does provide antecedent basis for the terminology “A computer-readable storage medium encoded with instructions configured to control a processor to perform a process.” In addition, support for the limitation “computer-readable storage medium” may be found in the specification, for example, at paragraph 53, which discloses that the memory means may include one or more smart cards, such as a SIM card. Thus, the specification does disclose the limitation “computer-readable storage medium” to exclude signal medium. Accordingly, the rejection of claims 35-36 is clearly erroneous.

Clear Error 3: “Introducing” Features Not Found in the Cited References

Claims 1-2, 6, 13-14, 22-23, and 35 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Appln. Pub. No. 2004/0246932 of Fischer (“Fischer”) in view of U.S. Patent Appln. Pub. No. 2002/0176366 of Ayyagari et al. (“Ayyagari”). Claims 7-8, 10-11, and 24 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Fischer in view of Ayyagari and further in view of U.S. Patent Appln. Pub. No. 2002/0131371 of Rudnick (“Rudnick”). The Office Action acknowledged that Fischer fails to disclose or suggest all of the features of claims 1-2, 6-8, 10-11, 13-14, 22-24, and 35, and cited Ayyagari and Rudnick to remedy the deficiencies of Fischer with respect to these rejected claims. Applicants respectfully submit that these rejections contain clear error because the “introducing” features recited in the claims are neither disclosed nor suggested in the cited references.

Specifically, the combination of Fischer and Ayyagari does not disclose or suggest, at least, “introducing an identifier list into at least some of the [broadcasted] beacon frames, the identifier list including identifiers of wireless terminals belonging to the ad- hoc network,” as recited in independent claim 1 and similarly recited in independent claims 22 and 35. The Office Action acknowledged that Fischer fails to disclose or suggest these features, and cited Ayyagari to remedy the deficiencies of Fischer with respect to these features. In particular, the Office Action asserted that these features are disclosed by Ayyagari at paragraph 49. In the cited portion, Ayyagari refers to a station (STA) that presents a list of visible service set identifiers (SSIDs) in an Ad Hoc mode to a user of the STA (*see also* Ayyagari at paragraph 38 and 44).

The list is generated by an initial scanning process followed by the retrieval of the list in the Windows platform, and includes information regarding STAs beaconing in the Ad Hoc mode. The user may select an Ad Hoc SSID from the list so that the STA associates with a particular cell. The Office Action alleged that the presenting of the list to the user of Ayyagari corresponds to the introducing of the identifier list into the broadcasted beacon frames of the claimed invention (*see* Office Action at page 7, second paragraph). The Office Action also asserted that since the list of Ayyagari is retrieved by beaconing, the list must be included into beacon frames (*see* Office Action at page 2, last paragraph, to page 3, first paragraph).

However, Ayyagari does not disclose or suggest introducing an identifier list into broadcasted beacon frames. Accordingly, Ayyagari fails to disclose or suggest, at least, **“introducing an identifier list into at least some of the [broadcasted] beacon frames, the identifier list including identifiers of wireless terminals belonging to the ad- hoc network”** (emphasis added) as recited in independent claim 1 and similarly recited in independent claims 22 and 35. In particular, the STA of Ayyagari does not introduce the list of SSIDs into beacon frames broadcasted to other STAs, but only presents the list to the user of the STA and generates the list via the initial scanning process and the retrieval of the list in the Windows platform, as discussed above. Contrary to the allegations of the Office Action, the presenting of Ayyagari cannot correspond to the introducing of the claimed invention because Ayyagari describes the STA presenting the list to only the user of the STA through a user interface (UI) of the STA (*see* Ayyagari at paragraphs 42 and 44-45). In other words, Ayyagari fails to disclose or suggest the STA broadcasting the list to other users of other STAs via beacon frames. In addition, the generating of the list of Ayyagari cannot correspond to the introducing of the identifier list of the claimed invention. Contrary to the assertions of the Office Action, the list of Ayyagari is not retrieved by beaconing, but generated by the STA’s initial scanning process that determines available wireless networks to which the STA may associate and retrieved in the STA’s Windows platform (*see* Ayyagari at paragraphs 49, 52, and 54). Ayyagari states, “The list **includes information regarding** the STAs beaconing in Ad Hoc mode” (emphasis added), and fails to disclose or suggest that the list **is retrieved from** the STAs beaconing in Ad Hoc mode (*see* Ayyagari at paragraph 49). Since the STA fails to broadcast the list in beacon frames, the STA cannot achieve an advantage of the claimed invention, which is “so that if/when the beacon broadcaster is to be changed, every terminal knows, based on the list, which of the terminals will

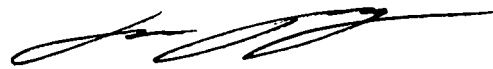
be the next beacon broadcaster, without having to contend with the other terminals for the broadcasting responsibility” (see Specification at page 8, lines 16-21).

Rudnick does not cure the deficiencies of Fischer and Ayyagari. Rudnick refers to a method of changing parameters in an 802.11 WLAN, but fails to disclose or suggest introducing an identifier list into broadcasted beacon frames.

Thus, independent claims 1, 22, and 35 are nonobvious, and the rejections of these claims are clearly erroneous. The subject matter of each of dependent claims 2, 6-8, 10-11, 13-14, and 23-24 (which each have their own scope) is nonobvious for similar reasons, and therefore, the rejections of these claims are clearly erroneous.

For the reasons set forth above, it is respectfully submitted that each of claims 1-37 recites subject matter that is neither disclosed nor suggested in the cited art. It is, thus, respectfully requested that all of claims 1-37 be allowed, and that this application be passed to issuance. Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
Notice of Appeal
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